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No. 95-723

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.

Petitioner,

v.

HILTON DAVIS CHEMICAL CO.,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF LITTON SYSTEMS, INC.,
AS AMICUS CURIAE
IN SUPPORT OF RESPONDENT**

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QUESTIONS PRESENTED

(1) Should this Court abandon the traditional rule recognized in *Graver Tank & Manufacturing Co. v. Linde Air Prods.*, 339 U.S. 605 (1950), under which patent infringement may be found whenever the accused product or process is "equivalent" to the invention claimed in the patent, as determined by a jury guided by proper instructions from the court as to function, way, and result?

(2) If this Court were to abandon or modify *Graver Tank* and its earlier precedents to the same effect, would it be free to disregard the settled expectations of patent holders who relied on *Graver Tank* in seeking patents and thereby disclosing their inventions to the public?

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**BRIEF OF LITTON SYSTEMS, INC. AS
AMICUS CURIAE IN SUPPORT OF RESPONDENT**

INTEREST OF AMICUS

With the consent of the parties,¹ *amicus curiae* Litton Systems, Inc. ("Litton"), hereby submits this brief in support of respondent Hilton Davis Chemical Co., to urge this Court to affirm the *en banc* decision of the Federal Circuit regarding infringement under the doctrine of equivalents. Although Litton has no interest in the outcome of the specific case at bar, it has a strong and abiding interest in the questions presented: (1) whether this Court should abandon the traditional understanding of the doctrine of equivalents as elaborated in almost two centuries of judicial development, culminating in *Graver Tank & Manufacturing Co. v. Linde Air Prods.*, 339 U.S. 605 (1950), and in hundreds of subsequent cases in the lower courts; and (2) whether — if this Court were to discard or modify the doctrine of equivalents — it would be free to ignore the settled expectations of patent holders, who have disclosed their inventions to the public through the patent process in the expectation that those inventions *would* be protected by the doctrine of equivalents as historically understood.

These questions have wide ramifications and enormous practical importance for many parties. For example, Litton is a technology-based company whose business activities depend heavily on innovation and intellectual property. Litton sought and obtained its patents on the express and judicially induced expectation that their enforceability was defined in part by the doctrine of equivalents as enunciated in *Graver Tank*. To deprive a patentee of that protection after the fact would constitute an impermissible taking of its property for public use without just compensation.

INTRODUCTION AND SUMMARY OF ARGUMENT

Petitioner urges "[a] clean abandonment of the 'doctrine of equivalents'" and maintains that there is no good reason for this

¹ Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

Court to “follow *Graver* at all.” Pet. Br. 12. According to petitioner, the doctrine of equivalents “flout[s]” the principle that a patent holder’s property right is defined by its patent claim (*id.* at 11), and the doctrine must at minimum be dramatically pruned.

Thus, petitioner urges this Court to ignore settled law and radically narrow, if not abolish altogether, a long-accepted feature of patent law judicially crafted to protect patentees from infringement by devices and methods that use substantially the same means, working substantially the same way, to accomplish substantially the same result. This Court should reject petitioner’s request and affirm the *en banc* decision of the Federal Circuit.

I. The doctrine of equivalents reflects principles of English common law and has been painstakingly elaborated through almost two centuries of federal judicial development. The doctrine protects the patents of inventors who have made substantial investments to develop new products and processes, and who have chosen to disclose their inventions to the world through the patent application process. Without the doctrine of equivalents, patent holders would be “at the mercy of verbalism,” and courts would be forced to “subordinat[e] substance to form.” *Graver Tank*, 339 U.S. at 607.

Congress has never displaced the equivalents doctrine by statute or expressed any opposition to it. And when Justice Black raised virtually all of petitioner’s objections to the doctrine of equivalents almost half a century ago in *Graver Tank*, a majority of this Court flatly rejected his arguments. Although Congress has repeatedly amended the patent code in the intervening decades, it has not accepted or acted on Justice Black’s criticisms. Accordingly, this Court should continue to reject those arguments today and should defer to Congress if there is a need to alter a doctrine on which current patentees have relied in good faith.

Petitioner contends that the doctrine of equivalents clashes with a patentee’s duty to describe the invention in detail and with sufficient clarity to satisfy the statutory criteria of 35 U.S.C. § 112. The central fallacy in this argument is that it confuses two distinct elements of patent infringement actions. As this Court made clear just last month in *Markman v. Westview Instruments, Inc.*, No. 95-

26, 64 U.S.L.W. 4263 (Apr. 23, 1996), “[t]he two elements of a simple patent case [are] [1] construing the patent and [2] determining whether infringement occurred.” *Id.* at 4267. Petitioner assumes that the doctrine of equivalents relates to the *first* element and that it operates to enlarge a patent claim. But in fact the doctrine is logically confined to the *second* element — determining whether infringement has occurred — and has always been invoked solely in that context. Accordingly, the doctrine is completely consistent with the patent scheme devised by Congress. Indeed, in the *Markman* decision, this Court stated that a patent “functions to forbid not only exact copies of an invention, but [also] products that go to ‘the heart of the invention but avoid the literal language of the claim by making a noncritical change’” or “deviat[e] from the core design in some noncritical way.” *Id.* at 4264 & n.1.

Notably, both the United States and the American Intellectual Property Law Association take the position, in briefs submitted *amici curiae*, that the statutory patent scheme has not displaced the doctrine of equivalents or replaced it with a judicial inquiry into the alleged infringer’s state of mind. Even several of petitioner’s own *amici* decline to endorse its sweeping argument. The Intellectual Property Owners observe that the doctrine of equivalents “is entirely consistent with th[e] [statutory] ‘claiming’ requirement” and that petitioner’s argument “is foreclosed by Congress’s ratification of the longstanding doctrine when, in 1952, Congress reenacted without change the law of infringement.” Br. *Amicus Curiae* at 2, 3. The Information Industry Counsel and Intel Corporation similarly agree that the doctrine of equivalents has not been superseded by Congress.

In short, there is no real support for petitioner’s request that this Court effectively abolish the doctrine of equivalents. Nor is there any merit to petitioner’s alternative suggestion that this Court radically restructure the doctrine by introducing heretofore unknown limits on its application. Such restructuring would eviscerate the ability of the doctrine to protect patentees from infringement. Br. of the United States 21-23 & n.7. In addition, petitioner’s argument flies in the face of longstanding precedent.

See, e.g., *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929) (later patented improvement infringed earlier patent under the doctrine of equivalents); *SRI Intern. v. Matsushita Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*) ("The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention.").

Finally, the Court of Appeals correctly held that application of the doctrine of equivalents is a matter for the jury, subject to proper instructions from the court. That traditional rule has been observed since the doctrine's inception. And there is a sound Seventh Amendment reason for it: The doctrine of equivalents is part of the inquiry into whether infringement has occurred. As this Court held in *Markman*, and as it has held repeatedly since the 19th century, the infringement inquiry is one of fact committed to the jury. See, e.g., *Silsby v. Foote*, 55 U.S. (14 How.) 218, 225 (1852); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 344 (1853).

Following precedent does not mean, as petitioner and some amici suggest, that the jury is free to decide the equivalents question at whim; rather, the courts give juries ample guidance through the clear and focused instructions that have been customary at least since *Graver Tank*. Any fear of an irrational jury is groundless, because a trial court has the authority to grant judgment as a matter of law or a new trial where the requirements of Fed. R. Civ. P. 50 and 59 are satisfied. But this case does not present an opportunity to complain about the guidance given the present jury, or to criticize the jury charge, for it is undisputed that Warner-Jenkinson did not object to the jury instruction in this case. Pet. App. 21a.

II. In any event, if this Court were to make any significant alteration in the doctrine of equivalents, such a ruling would have to be purely prospective and applicable only to patent applications filed after this Court's decision, or at most to patents issued after that date. In deciding to invest the substantial sums necessary to develop patents, and in deciding to file patent applications that disclose their otherwise secret inventions to the world, patent holders justifiably rely on the fabric of legal rules available to

enforce their property rights. The doctrine of equivalents is more than a strand in that fabric; it is fundamental to the very design. To abolish or significantly diminish the doctrine retroactively would disregard the basis of the bargain on which the patent holder was induced to rely. Accordingly, a retroactive ruling in this case would constitute a impermissible taking of property for public use without just compensation, and would also violate due process.

ARGUMENT

I. THE COURT OF APPEALS' VIEW OF THE DOCTRINE OF EQUIVALENTS WAS CORRECT

The Court of Appeals for the Federal Circuit properly recognized that "[t]his case presents an opportunity to restate — not to revise — the test for infringement under the doctrine of equivalents." Pet. App. 6a. The doctrine of equivalents is a settled principle of patent law, and there is no reason to disturb it.

A. The Court of Appeals' Decision Is Correct under *Graver Tank*

The Court of Appeals held that "[o]ften the function-way-result test will suffice to show the extent of the differences" between the claimed and accused products and, although it noted that "[o]ther factors, . . . such as evidence of copying or designing around, may also inform the test," it reasoned that, ultimately, "a finding of infringement under the doctrine of equivalents requires proof of insubstantial differences." Pet. App. 17a.

That decision is a faithful restatement of this Court's ruling in *Graver Tank*, which held that the doctrine of equivalents could be invoked "against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.'" 339 U.S. at 608 (citation omitted). This Court explained that "[t]he theory on which it is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.'" *Id.* (quoting *Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877)). This

Court added that the doctrine was above all one of "wholesome realism," and that "[w]hat constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum." *Id.* at 609. This approach is precisely the one taken by the Federal Circuit.

Furthermore, in *Graver Tank*, this Court was unpersuaded by the very arguments that petitioner advances here, almost all of which were offered in dissent by Justice Black in *Graver Tank*. Justice Black argued that the doctrine of equivalents is inconsistent with the congressionally devised patent scheme and its requirement of specific claiming, 339 U.S. at 613-14 (dissenting opinion); that the doctrine is inconsistent with the principle that "the function of claims . . . is to exclude from the patent monopoly field all that is not specifically claimed," *id.* at 614; that there is no need for the doctrine in light of the statutory provision for reissue of patents, *id.* at 614-15; that the doctrine would produce uncertainty and foster litigation, *id.* at 617; and that in any event it could not be applied in that case because the defendants in the infringement action were not accused of acting in subjective bad faith. *Id.* at 613.

Recognizing that an infringer could change the form while infringing the substance of a patent claim, this Court decisively rejected those arguments 46 years ago, and it should reject them again today. *Graver Tank* was correct as a matter of logic, precedent, and policy. On countless occasions since 1950, patentees, district courts, and courts of appeals have relied on it as the authoritative exposition of the doctrine of equivalents.

1. The stated objective of the Constitution in granting Congress the power to legislate in the area of intellectual property is to "promote the Progress of Science and useful Arts." Art. I, § 8, cl. 8. "The patent laws promote this progress by offering a right of exclusion for a limited period as an incentive to inventors to risk the often enormous costs in terms of time, research, and development." *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974). "In return for the right of exclusion . . . the patent laws impose upon the inventor a requirement of disclosure." *Id.* The

patent laws require that the patent application shall include a full and clear description of the invention and "of the manner and process of making and using it," 35 U.S.C. § 112, so that any person skilled in the art may make and use the invention at the expiration of the period of exclusion. 35 U.S.C. § 154(a)(2). This disclosure requirement ensures that "the knowledge of the invention enures to the people, who are thus enabled without restriction to practice it and profit by its use." *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 187 (1933). Thus, the inventor must choose between retaining his invention as a trade secret or putting in the public's hands and receiving a patent. "As Judge Learned Hand once put it: . . . 'he must content himself with either secrecy or legal monopoly.'" *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 149 (1989) (citation omitted).

The doctrine of equivalents plays a vital role in ensuring that the patent holder is not robbed of the benefit of this congressional bargain. For example, it may be impossible to foresee all of the development of new technologies — like microprocessors — that might permit competitors to infringe the substance of a patent while circumventing its literal terms. The doctrine of equivalents assures that patent holders are not "at the mercy of verbalism," and that courts are not forced to "subordinat[e] substance to form." *Graver Tank*, 339 U.S. at 607. "[T]he purpose of the doctrine of equivalents is to secure for the inventor a just reward for his or her invention." *Sarkisian v. Winn-Proof Corp.*, 697 F.2d 1313, 1321 (9th Cir. 1983). The doctrine reflects the sound view that "the patentee should not be deprived of the benefits of his patent by competitors who appropriate the essence of an invention while barely avoiding the literal language of the claims." *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991). Further, the doctrine of equivalents encourages competitors to innovate, by preventing mere copying and forcing would-be infringers to "invent[] around a patent by making a substantial change." *Id.*

As Judge Newman remarked in the Federal Circuit, "the major contribution of the doctrine of equivalents is now, and always has been, to the idea of a fairer, less technocratic, more practical patent

system; one that is oriented toward encouraging technologic[al] innovation and discouraging free riding." Pet. App. 44a (concurring opinion). "[T]he doctrine of equivalents can contribute a degree of added investment confidence to the inherently risky environment of new technologies." *Id.* So long as patentees have confidence in the patent system, they will continue to patent and the body of knowledge released to the public will continue to grow, even if petitioner were right that copyists might lose confidence in predicting whether their acts infringe. If, on the other hand, patentees lose confidence in the system and choose to keep their inventions secret, the body of knowledge released to the public will stagnate, even if increased copying promoted short-term price competition. Sean Moorhead, *The Doctrine of Equivalents: Rarely Actionable Non-Literal Infringement of the Second Prong of Patent Infringement Charges?*, 53 OHIO ST. L.J. 1421, 1427-28 (1992). International comparisons demonstrate the importance of the doctrine of equivalents in fostering technological innovation. See Bernard R. Pravel, *Why the United States Should Adopt the First-to-File System for Patents*, 22 ST. MARY'S L.J. 797, 807 (1991) ("[T]he doctrine of equivalents . . . is not available in most countries Thus, foreign patents are often so restricted in their protection that they are of insignificant or no value.").

2. Petitioner nonetheless contends that *Graver Tank* "stands in unavoidable and well-recognized tension with [a] long line of this Court's cases." Pet. Br. 43. To the contrary: the doctrine of equivalents is a traditional principle of patent law employed since the beginning of patent litigation. The doctrine traces to English common law, appearing, for example, in *Administrators of Calthorp v. Waymans*, 84 Eng. Rep. 966, 966 (K.B. 1676) (differences between patented engine and accused device "not material," because "though it vary in some circumstances so it be the same in the main"), and with respect to a 1695 patent granted by Parliament. See Christine MacLeod, *INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM 1660-1800*, at 73 (1988). In the United States, the doctrine was reflected in Justice Story's charge to a jury, as circuit justice, that "[m]ere colorable differences, or slight improvements, cannot shake the

right of the original inventor." *Ordiorne v. Winkley*, 18 F. Cas. 581, 582 (C.C.D.Mass. 1814) (No. 10,432). Justice Bushrod Washington similarly instructed a jury that, "[w]here the accused and patented] machines are substantially the same, and operate in the same manner to produce the same result, they must in principle be the same." *Gray v. James*, 10 F. Cas. 1015, 1016 (C.C.D.Pa. 1817) (No. 5,718); see also *Whitney v. Carter*, 29 F. Cas. 1070, 1078 (C.C.D.Ga. 1810) (No. 17,583) (using similar language); *Wyeth v. Stone*, 30 F. Cas. 723, 726 (C.C.D.Mass. 1840) (No. 18,107) (Story, Circuit Justice) ("[e]ach [device] performs the same service, substantially in the same way").

In the seminal decision of *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1853) — on which the unanimous opinion in *Markman* relied (see 64 U.S.L.W. at 4267) — this Court held that the question of infringement turned on whether the accused device could be said "substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention." 56 U.S. at 344. In *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. (7 Otto) 120 (1877), this Court found that "[a]uthorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape." *Id.* at 125.

By the time of *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U.S. 399, 406 (1905), this Court was able to describe the doctrine of equivalents as "well settled." Two decades later, this Court reaffirmed the doctrine in *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 20, 41-42 (1929).² Noted commentators of all

² See also *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 572 (1864) ("An infringement involves substantial identity, whether that identity be described by the terms, 'same principle,' same 'modus operandi,' or any other."); *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 556 (1870) (patentees "are entitled in all cases to invoke to some extent the doctrine of equivalents"); *Gould v. Rees*, 82 U.S. (15 Wall.) 187, 192 (1872) (inventors "have the . . . right to suppress every other subsequent improvement, not substantially different from what they have invented and secured by letters-patent."); *Ives*

eras have also approved of the doctrine of equivalents. See 1 William C. Robinson, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* §§ 245-258, at 334-54 (1890); Albert H. Walker, *TEXT-BOOK OF THE PATENT LAWS* §§ 349-367, at 252-67 (1895); 6 LIPSCOMB'S *WALKER ON PATENTS* §§ 22:34-22:40, at 541-56 (3d ed. 1987); see also *Feed Serv. Corp. v. Kent Feeds, Inc.*, 528 F.2d 756, 764 (7th Cir.) (Stevens, J., dissenting in part) (applying doctrine of equivalents), *cert. denied*, 429 U.S. 870 (1976).

3. In response to this overwhelming body of authority, petitioner insists that the doctrine of equivalents is inconsistent with the statutory requirement that the subject of a patent be precisely defined in the patent claims. 35 U.S.C. § 112. But this supposed inconsistency is a mirage. The central fallacy in petitioner's argument is that it confuses the question of claim construction with the issue of patent infringement.

To be sure, patents "must comply accurately and precisely with the statutory requirements as to claims of invention and discovery." Pet. Br. 19 (quoting *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938)). But, as this Court observed only recently in *Markman*, there are two distinct elements of a patent claim: construing the patent, and determining whether infringement has occurred. See 64 U.S.L.W. at 4267. The doctrine of equivalents has always been applied as part of the *second* inquiry.³

v. Hamilton, 92 U.S. (2 Otto) 426, 430 (1875) ("whether the defendants use the same or equivalent means; that is, the same, or substantially the same, combination of mechanical devices"); *Boyden Power-Brake Co. v. Westinghouse*, 170 U.S. 537, 569 (1898) (doctrine covers infringer who "reach[es] the same result" by "substantially the same or similar means"); *Kokomo Fence Mach. Co. v. Kitselman*, 189 U.S. 8, 24 (1903) (test is whether the devices at issue share "that identity of means and identity of operation which must be combined with identity of result to constitute infringement"); *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 421 (1908) (doctrine of equivalents is not limited to pioneer inventions).

³ See, e.g., *Kokomo Fence Mach. Co. v. Kitselman*, 189 U.S. 8, 23 (1903) ("the question is whether the specific improvements of the one actionable invaded the domain of the other," i.e., whether there "was a substantial

Accordingly, petitioner's alleged inconsistency is a figment of its imagination. There is no conflict between requiring patentees to spell out the specific metes and bounds of their patent claims with as much specificity as possible — and then applying the doctrine of equivalents to determine whether an accused device has trespassed upon that defined property zone. See Br. of United States 14-15. On the contrary, the doctrine of equivalents is a vital *supplement* to the congressionally devised scheme of specific claiming. "[A]s a prescription against sterile literalism . . . the doctrine of equivalents is fully consistent with the notion that the claim measures the scope of the patent monopoly." 4 Donald S. Chisum, *PATENTS* § 18.04[1], at 18-74 (1995).

4. Similarly, petitioner's suggestion that the doctrine of equivalents somehow disappeared with the adoption of the 1870 Patent Act (Pet. Br. 15-18) ignores the fact that the doctrine has been consistently enforced by the courts in the ensuing 126 years. Petitioner argues that a sea change swept away the doctrine of equivalents. In truth, the sea stayed still.

The patent laws have long contained a requirement that a patentee spell out the invention in sufficient detail to distinguish the prior art and to notify the public of the protection the patent confers. The very first patent act required that letters patent "describ[e] the said invention or discovery, clearly, truly, and fully." Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109. The applicant for a patent was at the time required to submit "a specification in writing, containing a description . . . of the thing or things by him or them invented or discovered, . . . which specification shall be so particular . . . as . . . to distinguish the invention or discovery from other things before known and used." *Id.* § 2. The Patent Act of 1836 similarly required that the applicant "shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention." Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117. Specific claiming was already the practice, even in 1836.

difference between the inventions"); *Hoyt v. Horne*, 145 U.S. 302, 308 (1892) (infringement issue includes equivalence inquiry); *Imhaeuser v. Buerk*, 101 U.S. (11 Otto) 647, 664 (1879) (same).

See Karl Lutz, *Evolution of the Claims of U.S. Patents*, 20 J. PAT. OFF. SOC'Y 457, 464 (1938).

The Patent Act of 1870 modified the statutory language only slightly, substituting the phrase "particularly point out and distinctly claim the part . . . which he claims." Patent Act of 1870, ch. 230, § 26, 16 Stat. 198, 201. Not surprisingly, the history of the Patent Act of 1870 suggests that the change in statutory text was not understood by anyone to have anything like the significance that petitioner would now attribute to it. The alteration was not mentioned in the records of the enactment. See Cong. Globe, 41st Cong., 2d Sess. 2681-83 (1870). The Commissioner of Patents subsequently wrote that "[i]n 1870 the patent law was revised, but the revision was in the nature of a consolidation of the statutes then in force." Charles Eliot Mitchell, Commissioner of Patents, *An Address Delivered at the Proceedings of the Congress on the "Birth and Growth of the American Patent System"* (1890), reprinted in PATENT CENTENNIAL CELEBRATION PROCEEDINGS AND ADDRESSES 52 (1891).

Thus, the doctrine of equivalents was developed alongside a system in which patentees were required to detail the nature and scope of their claims. And increasing specificity in claim style makes the need for the doctrine of equivalents *more* urgent, not less; as Judge Newman commented in the Federal Circuit, "the increasing specificity in claim style probably made it easier for the 'unscrupulous copyist,' the words of *Graver Tank*, to appropriate the substance of the invention while evading the letter of the claims." Pet. App. 37a (concurring opinion).

5. Petitioner alternatively urges that, if this Court does not abandon the doctrine of equivalents altogether, it should nonetheless hold that the doctrine does not extend to matters surrendered during the patent application process (whatever the reason) or to matters not disclosed as equivalent in the patent application. But most of this Court's decisions in the course of the doctrine's lengthy development did not even *mention* the principles proposed by petitioner, let alone apply them in holdings.⁴ And

⁴ See, e.g., Albert H. Walker, TEXT-BOOK OF THE PATENT LAWS §§ 354-55,

Graver Tank's holding cannot be so restricted. *Graver Tank* reaffirmed *Sanitary Refrigerator* (see 339 U.S. at 608), which expressly rejected limiting equivalents to those disclosed as such in the patent. *Graver Tank* also refused to adopt any rigid "formula" (339 U.S. at 609) such as that proposed by petitioner.

Moreover, the facts of *Graver Tank* cannot be used to narrow the doctrine, for they prove just the opposite of what petitioner claims. As Justice Black observed, "the similar use of manganese in prior expired patents, referred to in the Court's opinion, raises far more than a suspicion that its elimination from the valid claims stemmed from fear that its inclusion by name might result in denial or subsequent invalidation of respondent's patent." 339 U.S. at 616-17 (dissenting opinion). He concluded that "it would be frivolous to contend that failure specifically to include that substance in a precise claim was unintentional." *Id.* at 616. Yet a majority of this Court was willing to apply the doctrine of equivalents because there had been no surrender to overcome a prior art reference.

Hence, it is well established that the doctrine of equivalents is not limited to equivalents disclosed in the patent. Indeed, "[i]n order to be an equivalent of another, it is not necessary that the device have been known at the time of the machine which contains the latter." 6 LIPSCOMB'S WALKER ON PATENTS §§ 22:34-22:40, at 541-56 (3d ed. 1987).⁵ The patent owner is not expected to

at 256-59 (1885) ("Whether a device, in order to be an equivalent of another, must have been known at the time of invention or of the patent . . . [is a] view that seems to have originated in the mind of Justice Clifford . . . [A]fter formulating the doctrine he was content to ignore it No other Supreme Court justice has ever inserted just such doctrine . . . into any opinion of that tribunal. Several cases have been adjudicated in that court, which called for the application of that doctrine, if it is a true one, but it has never been applied to any necessary issue pending therein.").

⁵ See *Cantrell v. Wallick*, 117 U.S. 689, 695 (1886); *Clough v. Barker*, 106 U.S. 166, 177-78 (1882); *Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878); *Cochrane v. Deener*, 94 U.S. 780, 790 (1877); *Mason v. Graham*, 90 U.S. 261, 275 (1875); *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 573 (1864); *O'Reilly v. Morse*, 56 U.S. 62, 123-24 (1854); *Texas Instruments, Inc. v. United States*

"predict all future developments which enable the practice of his invention in substantially the same way." *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1362 (Fed. Cir. 1983). This Court has held that a later improvement, even if patented, may still violate the doctrine of equivalents if it satisfies the function-way-result test. See *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 20, 40, 43 (1929); see also *Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1580-81 (Fed. Cir. 1984). Otherwise, unforeseeable technological developments with wide applications, like microprocessors, digital (rather than analog) systems,⁶ or new chemical processes, would in effect sweep away existing patents altogether. See Br. of United States 21-23 & n.7.

In addition, it is settled law that file wrapper estoppel prevents a patentee from reclaiming, through the doctrine of equivalents, what was willfully surrendered before the Patent Office only if the reason for the limiting argument or amendment was to delete prior art embodiments that would otherwise have invalidated the patent.⁷ This Court should reject petitioner's cavalier attempt to make radical revisions in the doctrine of equivalents without due regard for the careful development of the law in the Federal Circuit.

Int'l Trade Comm'n, 805 F.2d 1558, 1563 (Fed. Cir. 1986); *SRI Intern. v. Matsushita Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*).

⁶ See, e.g., *Decca Ltd. v. United States*, 544 F.2d 1070, 1080-81 (Ct. Cl. 1976) (digital devices infringed claims relating to analog devices, even though later-developed digital devices were not predicted by, let alone eliminated from the scope of, the patent).

⁷ See, e.g., *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1358 (Fed. Cir. 1991); *Insta-Foam Products, Inc. v. Universal Foam Systems, Inc.*, 906 F.2d 698, 703 (Fed. Cir. 1990); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 658-60 (Fed. Cir. 1986); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 871 (Fed. Cir. 1985); *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1362 (Fed. Cir. 1983); *Omark Indus., Inc. v. Textron*, 688 F.2d 1242, 1251-52 (9th Cir. 1982).

B. Congress Did Not Displace *Graver Tank* in the 1952 Patent Act

Petitioner argues that the 1952 Patent Act should be construed as displacing a century of well-settled, judge-made law under the doctrine of equivalents. This argument is flatly wrong as a matter of basic principles of statutory construction.

There is no suggestion that anything in the text of the 1952 Patent Act or in its legislative history remotely shows that Congress intended to overrule *Graver Tank*. It is barely conceivable, and far too speculative to proceed on the assumption, that Congress would have intended to displace so longstanding a feature of patent law without any explicit textual reference or other contemporaneous indication of its decision to do so. This is therefore one of those instances where "Congress' silence . . . can be likened to the dog that did not bark." *Chisom v. Roemer*, 501 U.S. 380, 396 n.23 (1991).

To the contrary, this Court has already determined that the 1952 Patent Act "left intact the entire body of case law on direct infringement." *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 342 (1961). That body of case law included the doctrine of equivalents. No less an authority than Justice Black (a dissenter in *Graver Tank*) acknowledged that the purpose of the 1952 Act in relevant part was to codify extant patent law. *Aro Mfg.*, 365 U.S. at 347 n.2 (Black, J., concurring). And even petitioner concedes the principle that "a law designed substantially (even though not entirely) to codify and restate prior law generally is understood to incorporate then-existing judicial interpretations." Pet. Br. 42 (citing *Davis v. United States*, 495 U.S. 472, 482 (1990); *Pierce v. Underwood*, 487 U.S. 552, 566-68 (1988)). Indeed, this Court has frequently held, in setting forth ground rules that shape as well as describe how Congress proceeds, that Congress legislates against the background understanding that its enactments incorporate longstanding principles of judge-made law.⁸

⁸ See, e.g., *Square D. Co. v. Niagara Frontier Tariff Bureau, Inc.*, 476 U.S. 409, 419, 421-22 (1986) (upholding "continued viability" of prior case law

The only remotely relevant change in the 1952 Patent Act confirms that Congress did not intend to displace the doctrine of equivalents. Paragraph 6 of § 112 added the concept of equivalents as a basis for sustaining previously invalid "means" claims regarding elements in a combination. 35 U.S.C. § 112, ¶ 6.⁹ The plain purpose of this provision was to restore to patentees the ability to use in their claims broad "means plus function" language, which this Court had held was unduly vague. *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). Thus, this statutory change confirms that Congress was fully aware of the concept of equivalents and simply adapted it to a new function: salvaging vague claims by extending the consideration of equivalents to products or processes disclosed in specifications. As petitioner's own *amici* recognize, it would be perverse to afford the benefits of the doctrine of equivalents to patentees who use the vaguest claim language, while denying it to those who set forth their claims clearly and distinctly. Br. of Intellectual Property Owners 14-15.

Moreover, since 1952, the lower courts have applied the doctrine of equivalents in hundreds of decisions.¹⁰ Congress has taken no action indicating that it disagrees with this interpretation of the patent laws, even though Congress *has* felt the need to amend

that "represents a longstanding statutory construction that Congress has consistently refused to disturb, even when revisiting this specific area of law"); *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 549 (1985) (concluding that Congress meant to incorporate in the Copyright Act the common law regarding "fair use"); *Tower v. Glover*, 467 U.S. 914, 920 (1984) (inferring from legislative silence that Congress did not intend to abrogate common-law immunities for governmental officers when it imposed liability under 42 U.S.C. § 1983).

⁹ Although equivalence analysis under § 112, ¶ 6 is not the same as that under the doctrine of equivalents, see *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993), the statutory change indicates that Congress was familiar with the equivalence concept.

¹⁰ By our count, the doctrine has been applied since 1952 in 177 published decisions in the courts of appeals and 342 decisions in the district courts.

the patent code on numerous occasions during this time.¹¹ Congressional acquiescence in this established judicial practice — and Congress' ability to change it prospectively at any time — counsel heavily against departing from the doctrine of equivalents. "'Considerations of state decisis have special force . . . [where] Congress remains free to alter what [this Court] ha[s] done.'" *Eastman Kodak Co. v. Image Technical Services, Inc.*, 504 U.S. 451, 479 n.29 (1992) (quoting *Patterson v. McLean Credit Union*, 491 U.S. 164, 172-73 (1989)).

C. Under *Markman* and this Court's 19th-Century Precedents, Application of the Doctrine of Equivalents Must Be Left for the Jury

In *Markman v. Westview Instruments, Inc.*, No. 95-26, 64 U.S.L.W. 4263 (Apr. 23, 1996), this Court clarified the respective roles of the judge and jury in suits for patent infringement. This Court began by observing that "there is no dispute that infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago." *Id.* at 4265. This Court further noted that, at common law, juries were charged with the responsibility of deciding not only the historical question of whether infringement occurred, but also factual questions relating to enablement (whether the specification described the invention well enough to permit members of the trade to reproduce it) and novelty (whether any essential part of the patent had been previously disclosed to the public). *Id.* at 4266. This Court indicated that these sometimes complex and technical questions were solely for the jury.

But this Court found that there was insufficient evidence regarding 18th-century practice in patent cases "to support an argument by analogy that today's construction of a claim should be a guaranteed jury issue." *Id.* This Court focused on the fact that claims interpretation is essentially an exercise in reviewing documentary evidence, and it remarked that "in other kinds of cases during this period judges, not juries, ordinarily construed written

¹¹ Section 112, for example, was amended in 1965, see Pub. L. 89-83, § 9, 79 Stat. 261, and again in 1975. Pub. L. 94-131, § 7, 89 Stat. 691.

documents.” *Id.*

This Court also consulted 19th-century American practice, and it found instructive Justice Curtis’ explication of the elements of a patent infringement claim: “*construing* the patent . . . ‘is an issue of law, to be determined by the court,’” while “*determining whether infringement occurred* . . . ‘is a question of fact, to be submitted to a jury.’” *Id.* at 4267 (emphasis added and quoting *Winans v. Denmead*, 56 U.S. at 338). All of the considerations invoked in *Markman* demonstrate that application of the doctrine of equivalents is properly reserved for the jury.

1. Unlike claim construction, the doctrine of equivalents has always been a matter for the jury as part of the inquiry into whether infringement has occurred.¹² The doctrine of equivalents is not part of the process of claim construction, which this Court held in *Markman* was properly reserved for the court. Rather, just as the jury must determine literal infringement through its common sense and understanding of technical issues, so it must also decide infringement under the doctrine of equivalents using the same tools it would use to resolve the issue of literal infringement.

The rule is long-settled that “whether two arts or devices are ‘equivalent’ is a matter of fact for the jury.” 1 William C. Robinson, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 246, at 336 n.1 (1890). The doctrine of equivalents was applied in a 1676 infringement action tried before a jury. *Administrators of Calthorp v. Waymans*, 84 Eng. Rep. 966 (K.B. 1676). Consistent with English common-law practice,¹³ Justices Story and Washington,

¹² Although sometimes described as “equitable,” the doctrine of equivalents has that flavor only in the broadest sense of reflecting “general fairness,” not in the sense of the law-equity distinction for Seventh Amendment purposes. Pet. App. 16a. Notably, *Graver Tank* did not characterize the doctrine as “equitable.”

¹³ See *Huddart v. Grimshaw*, 1 Webs. Pat. Cas. 85, 95 (1803) (jury to determine whether “the same effect in substance is produced”); *Hill v. Thompson and Forman*, 1 Webs. Pat. Cas. 239, 242 (1818) (jury asked “whether the mode of working by the defendant has, or has not, been essentially or substantially different”); *Jones v. Pearce*, 1 Webs. Pat. Cas. 122,

riding circuit in 1814 and 1817, held that juries were to apply the doctrine of equivalents. See pp. 8-9, *supra*. And when the full Court first encountered the doctrine — in a legal action for infringement — it squarely held that the question of “whether, in point of fact, the defendant’s [devices] did copy the plaintiff’s invention, in the sense above explained [*i.e.*, by an equivalent], is a question for the jury.” *Winans v. Denmead*, 56 U.S. (15 How.) 330, 344 (1853). This Court has never retreated from that basic principle where the jury is the trier of fact.

In *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1872), for example, this Court explained that disputed factual issues on the question of the “diversity or identity” of the patented and accused devices “must be submitted to the jury, if there is so much resemblance as raises a question at all.” This Court added:

And though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may on this mixed question of law and fact, lay down to the jury the law which should govern them, so as to guide them to truth, and guard them against error, and may, if they disregard instructions, set aside their verdict, the ultimate response to the question must come from the jury.

124 (1832) (jury instructed: “if you think it is applied in the same way as according to the plaintiff’s patent . . . then the want of two or three circumstances in the defendant’s wheel, which are contained in the plaintiff’s specification,” would not preclude infringement); *Morgan v. Seaward*, Goodeve’s Pat. Cas. 307, 307 (1835) (“You [the jury] are to look to the substance and not to the mere form”); *Walton v. Potter & Horsfall*, 1 Webs. Pat. Cas. 585, 587 (1841) (jury to “see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff’s invention”); *De La Rue v. Dickenson*, Goodeve’s Pat. Cas. 164, 166 (1857) (whether “the defendant has used substantially the same means to obtain the same result” is question “which the judge is bound to submit to the jury”); John Norman, *NORMAN ON PATENTS* *134 (1853) (“[T]he jury must consider whether the defendant’s machine is only colourably different. . . . [T]he jury should look to the substance, and not the mere form; and if it is in substance an infringement, they ought to find it so.”).

Id. So too in *Gould v. Rees*, 82 U.S. (15 Wall.) 187 (1872) — on which this Court relied in *Graver Tank*, 339 U.S. at 608 — this Court explained a century and a quarter ago that “if the ingredient substituted performs *substantially the same function* as the one withdrawn it would be correct to instruct the jury that such a substitution of one ingredient for another would not avoid the charge of infringement.” 82 U.S. at 193 (emphasis added).

Similarly, in *Coupe v. Royer*, 155 U.S. 565 (1895), this Court remarked that it had “had occasion, more than once, to reverse the trial courts for taking away from the jury the question of infringement,” including whether differences between the devices are “material.” *Id.* at 577, 579; see also *Royer v. Schultz Belting Co.*, 135 U.S. 319, 325 (1890) (“whether the defendant’s machine infringed [the patentee’s] claims, was a question of fact for the jury to determine, on all the evidence which the case might present. It was not a matter of mere judicial knowledge that the mechanical differences between the two machines were material”); *Keyes v. Grant*, 118 U.S. 25, 36 (1886) (whether patent and publication “described the same thing . . . was a question of fact properly left for determination to the jury”); *Tyler v. Boston*, 74 U.S. (7 Wall.) 327, 330-31 (1869) (“whether one compound of given proportions is substantially the same as another compound varying in the proportions — whether they are substantially the same or substantially different — is a question of fact and for the jury”); *Carver v. Hyde*, 41 U.S. (16 Pet.) 513, 520 (1842) (“whether the manner was the same in substance or not, was a question of fact for the jury”).¹⁴

¹⁴ See also *May v. County of Fond Du Lac*, 27 F. 691, 697 (C.C.E.D. Wis. 1886) (“whether the defendant has used substantially the same means, or mechanically speaking, equivalent means, to accomplish the same result . . . is a question for the jury to determine.”); *Tatham v. Le Roy*, 23 F. Cas. 718, 719 (C.C.S.D.N.Y. 1850) (No. 13,762) (jury was charged to decide whether devices “were substantially different from those of the plaintiffs”); *Blanchard’s Gun-Stock Turning Factory v. Warner*, 3 F. Cas. 653, 658 (C.C.D. Conn. 1846) (No. 1,521) (“We think it was a question of fact for the jury whether this was a substantial variation or not”); *Smith v. Pearce*, 22 F.

2. Submitting the issue of equivalents to the jury is but a logical corollary of the rule that, as this Court recognized in *Markman*, factual disputes relating to the question of infringement have, under the Seventh Amendment, always been decided by a jury when it is the trier of fact. 64 U.S.L.W. at 4265, 4267. Indeed, in *Markman*, this Court discussed the decision in *Bischoff v. Wethered*, 9 Wall. 812 (1870), in precisely these terms. This Court explained that *Bischoff* is “a case in which the Court drew a line between issues of document interpretation and product identification, and held that expert testimony was properly presented to the jury on the latter, ultimate issue, whether the physical objects produced by the patent were identical.” 64 U.S.L.W. at 4268. In *Markman*, this Court acknowledged that *Bischoff* had recognized the primacy of the jury over questions regarding “the character of the thing invented, which is sought in questions of identity and diversity of inventions.” *Id.* (quoting *Bischoff*, 9 Wall. at 816).

Also instructive in this respect is *Silsby v. Foote*, 55 U.S. (14 How.) 218 (1852), where the opinion for the Court was delivered by Justice Curtis, the very jurist whose views this Court found authoritative in *Markman*. See 64 U.S.L.W. at 4267. In *Silsby*, Justice Curtis held for the Court that a trial judge properly “left . . . matter[s] of fact to the jury” in determining that the jury was to decide whether an accused device had infringed upon a patented stove. 55 U.S. at 225.

The issue in *Silsby* was almost identical to that under the doctrine of equivalents: whether the defendant had made a substantial change from the patent claim. In *Silsby*, the trial court had ruled that the patent covered “a combination of such of the described parts as were combined and arranged for producing a particular effect, viz., to regulate the heat of the stove.” *Id.* at 225. But this construction of the patent claim still left a dispute as to

Cas. 619, 620 (C.C.D. Ohio 1840) (No. 13,089) (“The jury are to judge by an inspection of the models and from the evidence, whether the two machines differ in principle.”); *Alden v. Dewey*, 1 F. Cas. 329, 330 (C.C.D. Mass. 1840) (No. 153) (Story, Circuit Justice) (asking jury, “Are the means used substantially the same, although not in every minute particular?”).

which parts were necessary to regulate the heat of a stove. The trial court left this question to the jury. The defendants objected, “desir[ing] the Judge to instruct the jury that the index, the detaching process, and the pendulum, were constituent parts of this combination.” *Id.*

But this Court rejected that challenge: “How could the Judge know this as a matter of law? . . . [I]t therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into, and constitute an essential part of this combination.” *Id.* at 226. This Court explained that it was “a question of fact which of the described parts are essential to produce that result; and to this extent, not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury.” *Id.*

Silsby, in conjunction with *Winans* — authored by the same Justice one year later — makes historical practice clear. In *Winans*, this Court reversed a circuit court that had refused to submit the equivalence question to the jury, and in *Silsby*, this Court upheld the submission of similar issues to the jury.

3. In *Markman*, this Court reached the conclusion that the historical evidence was ambiguous regarding the jury’s role in interpreting the *language* of patent claims. Only then did this Court find it useful to look to “functional considerations” (64 U.S.L.W. at 4268) in determining the jury’s proper role. Here, there is no ambiguity and thus no need to consider such matters because this Court has held for more than a century that the equivalence question is to be decided by a jury. In any event, practical concerns in this case also militate in favor of the right to jury trial.

In *Markman*, this Court noted that, at common law, construction of written documents was a task traditionally performed by judges rather than juries. *Id.* at 4266. And, with respect to contemporary practice, this Court predicted that patent construction would rarely turn on “credibility judgment[s]” or courtroom evaluations of witnesses but rather would typically hinge on review of a cold written record — a process peculiarly within the expertise of judges. 64 U.S.L.W. at 4268.

By contrast, application of the doctrine of equivalents involves

broad-based “inquiries of fact,” *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 416 (1908), that are obviously not limited to construing written documents. As this Court observed in *Graver Tank*:

A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence.

339 U.S. at 609-10.

Nor does any supposed need for uniformity — another practical consideration that this Court discussed in *Markman* only after concluding that the historical evidence was ambiguous — justify denial of the Seventh Amendment right to jury trial. *Markman* analyzed the value of uniformity solely in the context of “submitting issues of *document construction* to juries.” 64 U.S.L.W. at 4269 (emphasis added). The separate question of *infringement* has always been a fact-dependent one on which different juries may reach different answers as to different accused devices. If an infringer prevails before one jury, offensive collateral estoppel can restrict a patentee’s ability to relitigate an issue. *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971). Conversely, if the patentee prevails, a second infringer with separate counsel and possibly different evidence is entitled to its own opportunity to litigate the issue. If a supposed need for uniformity could justify trenching on the jury’s role in applying the doctrine of equivalents, it could justify invading any other aspect of the jury’s role in determining whether infringement has occurred — and in fact any aspect of the jury’s role in any kind of case in federal court, for different juries are typically allowed to reach different answers as to whether a given product was defective or particular conduct was negligent.

Accordingly, under *Markman*, the Seventh Amendment requires that factual disputes involving applications of the doctrine of

equivalents be submitted to a jury where it is the trier of fact.

4. This does not mean, of course, that the jury is free from all constraint in deciding the question. The court must instruct the jury regarding the proper test to apply (*i.e.*, function, way, result), just as it must with any legal standard — like negligence, product defect, unreasonable restraint of trade, and punitive damages. The Court of Appeals stressed below that the doctrine of equivalents “is an issue of fact to be submitted to the jury in a jury trial *with proper instructions*.” Pet. App. 17a (emphasis added). There need be no danger that the jury will be left without sufficient guidance. And the trial court retains the power to grant judgment as a matter of law and a new trial where appropriate. Fed. R. Civ. P. 50 and 59.

There is no occasion, however, for going further and strait-jacketing the jury by instructing it precisely how to apply the doctrine of equivalents in a particular case. *See* Br. of Information Technology Industry Assn. and Intel Corp. 13 (jury must have “instructions from the court that circumscribe the appropriate function/way/result parameters”).¹⁵

First, under Fed. R. Civ. P. 51, the content of jury instructions is not properly before this Court because Warner-Jenkinson did not object at trial to the instructions given regarding the doctrine of equivalents. Pet. App. 21a.

Second, this Court has already rejected *amici*'s proposal. In *Silsby*, this Court held that a judge could not “know . . . as a matter of law” the sort of factual information that *amici* seek to have incorporated in the jury instructions. 55 U.S. at 226. *See also Markman*, 64 U.S.L.W. at 4267 (“In order to resolve the *Bischoff*

¹⁵ The United States represents only that “it is inclined to believe that ‘reference of the entire issue to the jury was erroneous’ (Br. of United States 16 n.3) — a position that would leave substantial authority in the jury. The American Intellectual Property Law Association takes the view that the court should decide ‘all aspects of claim interpretation — literal and equivalent’ but that ‘[f]actual issues of *what the accused device or process is*, and whether it falls within the judge-defined claim scope, are reserved to the jury.’” Br. *Amicus Curiae* 11. Both briefs were submitted before this Court's decision in *Markman*, and neither brief addresses the tradition of reserving the equivalents issue to the jury.

suit implicating the construction of rival patents, we considered ‘whether the court below was bound to compare the two specifications, and to instruct the jury, as a matter of law, whether the inventions therein described were, or were not, identical.’ 9 Wall. at 813 (statement of the case). We said it was not bound to do that, on the ground that investing the court with so dispositive a role would improperly eliminate the jury's function in answering the ultimate question of infringement.”); *Coupe v. Royer*, 155 U.S. at 578 (“counsel cannot require the court to compare the two specifications and to instruct the jury, as a matter of law, whether the inventions therein described are or are not identical”); *May v. County of Fond Du Lac*, 27 F. 691, 696-97 (C.C.E.D. Wis. 1886) (“An infringement involves substantial identity No certain, definite rule can be stated by which to determine unerringly, in every case, what will amount to substantial identity. The jury, guided by general principles, must determine each case upon its own circumstances.”) (citation omitted).

Third, there are sound reasons behind the traditional rule. Instructing the jury as a matter of law what *is* or is *not* “substantially the same” would often predetermine the verdict's outcome and rob the right to jury trial of all meaning. Conversely, the district court would be converted from a tribunal of law to one of science and technology. But district court judges are not “amateur scientists.” *Daubert v. Merrill Dow Pharmaceuticals, Inc.*, 113 S. Ct. 2786, 2800 (1993) (Rehnquist, C.J., concurring in part and dissenting in part).

Petitioner's *amici* urge this Court to place artificial restraints upon the jury that are inconsistent with the Seventh Amendment and not used in any other type of case in the federal courts. “There is neither reason nor authority for employing in a patent trial procedures and practices different from those employed in any other civil trial. Indeed, reason and authority mandate the contrary.” Chief Judge Howard T. Markey, *On Simplifying Patent Trials*, 116 F.R.D. 369, 370 (1987).

II. ANY CHANGE IN THE DOCTRINE OF EQUIVALENTS SHOULD BE MADE PURELY PROSPECTIVE

For all of the above reasons, this case presents no occasion to depart from the well-established contours of the doctrine of equivalents. But if there were to be any revision in this rule developed by the federal judiciary for almost two centuries, it would at least have to be undertaken with due regard for the settled property rights of patent holders. Accordingly, any ruling in favor of petitioner should be made purely prospective.

1. This Court has long recognized that "[c]onsiderations of *stare decisis* are at their acme in cases involving property and contract rights, where reliance interests are involved." *Payne v. Tennessee*, 501 U.S. 808, 828 (1991). The principle is especially salient in this case, for it cannot be disputed that "[r]ights secured to an inventor by letters-patent are property which consists in the exclusive privilege of making and using the invention, and of vending the same to others to be used, for the period prescribed by the Patent Act." *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. (7 Otto) 120, 120 (1877). In addition, the confidential proprietary information disclosed by patentees as part of the patent process is itself a valuable and constitutionally protected property right. See *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1003-04 (1984).

Before deciding whether to commit the substantial sums necessary to develop a new product or process, and to submit a patent application disclosing the invention to the world, a patentee weighs the strength, breadth, and enforceability of a prospective patent, together with other market benefits and risks. In a very real and practical sense, part of a patent holder's *property* encompasses the extant legal rules upon which he is entitled to rely to enforce his property. The doctrine of equivalents is a significant element in that bundle of rules. Even petitioner's *amici* concede that "[t]he doctrine of equivalents affects a host of significant business decisions, including: whether to launch products into or remove them from commerce; whether or how to alter designs of products, processes, and machines; and whether to seek or grant licenses. Those decisions influence not only enormous financial commitments but also momentous changes in investment

decisions." Br. of Information Technology Assn. and Intel Corp. 3.

"Investment-backed expectations" are the essence of private property rights. *Penn Central Transp. Co. v. City of New York*, 438 U.S. 104, 124 (1978). To abolish the doctrine of equivalents or reduce it to a mere opportunity to appeal to a judge's discretion, *cf. Perry v. Sindermann*, 408 U.S. 593, 603 (1972) (essence of property is more than "subjective expectancy"), would defeat the settled expectations of existing patent holders who justifiably relied on that doctrine's role in "expand[ing] the right to exclude to 'equivalents' of what is claimed." Br. of United States 15 (quoting *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir.), *cert. denied*, 498 U.S. 992 (1990)).¹⁶

2. This Court has long held that "rights secured under the grant of letters patent by the United States [a]re property and protected by the guarantees of the Constitution and not subject therefore to be appropriated even for public use without adequate compensation." *William Cramp & Sons Ship & Engine Bldg Co. v. International Curtis Marine Turbine Co.*, 246 U.S. 28, 39-40 (1918). To alter, retroactively, the terms on which a patent is granted would work an obvious taking of private property. See, e.g., *Richmond Screw*

¹⁶ Petitioner argues that there can be no justifiable reliance on a doctrine that "has been the subject of expansion, contraction, refinement, and questioning since the Federal Circuit was created." Pet. Br. 49. But such incremental modifications are in the nature of judge-made law. The alleged "meanderings" to which petitioner refers (Pet. Br. 49 n.33) plainly concern peripheral issues, not the existence of the doctrine of equivalents itself. In light of this Court's authoritative decision in *Graver Tank*, which has now been reaffirmed twice by *en banc* decisions in the Federal Circuit — once in the instant case, and a decade ago in *SRI Intern. v. Matsushita Corp. of America*, 775 F.2d 1107, 1123-24 (Fed. Cir. 1985) — the justifiability of relying on the doctrine cannot be doubted. See Chief Judge Howard T. Markey, *The Federal Circuit and Congressional Intent*, 41 AM. U.L. REV. 577, 579 (1992) ("Such case-by-case development of the law is normal and will doubtless continue. . . . [M]ost observers would agree that a combination of careful decisionmaking and willingness to correct error have resulted in a substantial and consistent body of jurisprudence, the study of which enables counsel to more confidently advise a clientele.").

Anchor Co. v. United States, 275 U.S. 331, 345 (1928) (elimination of infringement action "is an attempt to take away from a private citizen his lawful claim for damage to his property by another private person, which but for this act he would have against the private wrongdoer. This result . . . would seem to raise a serious question . . . under the Fifth Amendment to the Federal Constitution.").

Unlike the Impairment of Contracts Clause, which applies only against legislatures, *Tidal Oil Co. v. Flanigan*, 263 U.S. 444 (1924), the Takings Clause forbids uncompensated confiscation by the judiciary as well as by the legislative branch. See, e.g., *Lucas v. South Carolina Coastal Council*, 505 U.S. 1003, 1031 (1992); *Webb's Fabulous Pharmacies, Inc. v. Beckwith*, 449 U.S. 155, 164 (1980). "No more by judicial decree than by legislative fiat may a [government] transform private property into public property without compensation." *Stevens v. City of Cannon Beach*, 114 S. Ct. 1332, 1334 (1994) (Scalia, J., joined by O'Connor, J., dissenting from the denial of certiorari).

The absence of confiscatory intent does not excuse a judicial taking of property. *Hughes v. Washington*, 389 U.S. 290, 298 (1967) (Stewart, J., concurring). And the absence of congressional authorization for the kind of judicial taking that retroactive overruling of *Graver Tank* would entail means that such a judicial action would be even more constitutionally problematic than a confiscation by the political branches, which would typically trigger a right to pursue relief under the Tucker Act, 28 U.S.C. § 1491(a)(1). See *Regional Rail Reorganization Act Cases*, 419 U.S. 102, 127 n.16 (1974).

We need not show that a retroactive overruling of *Graver Tank* would serve the interests only of a few private litigants, like petitioner here. Even conceding that the public use requirement might be met, see *Hawaii Housing Auth. v. Midkiff*, 467 U.S. 229, 239-44 (1984), one of the principal purposes of the Takings Clause is "to bar Government from forcing some people alone to bear public burdens which, in all fairness and justice, should be borne by the public as a whole." *Dolan v. City of Tigard*, 114 S. Ct. 2309, 2316 (1994) (quoting *Armstrong v. United States*, 364 U.S. 40, 49

(1960)).

3. Even apart from the Takings Clause, commitment to the rule of law and respect for its presupposition of governmental regularity, both of which the Due Process Clause embodies, would forbid a sudden change in judicial course that would upset the settled and legitimate expectations of patent holders. In *Heckler v. Community Health Services*, 467 U.S. 51 (1984), this Court observed that, "when the Government acts in misleading ways, it may not enforce the law if to do so would harm a private party as a result of governmental deception." *Id.* at 61 n.12 (citing, *inter alia*, *Kaiser Aetna v. United States*, 444 U.S. 164, 178-80 (1980), and *Santobello v. New York*, 404 U.S. 257 (1971) (due process)); see also *Raley v. Ohio*, 360 U.S. 423, 438-40 (1959) (due process). The *Heckler* Court further noted that "this principle also underlies the doctrine that an administrative agency may not apply a new rule retroactively when to do so would unduly intrude upon reasonable reliance interests." 467 U.S. at 61 n.12 (citing *NLRB v. Bell Aerospace Co.*, 416 U.S. 267, 295 (1974)). Precisely the same principle is applicable here.

4. The rule now adopted by a majority of this Court under which decisions of federal constitutional law are ordinarily given retroactive effect, see *Harper v. Virginia Dept. of Taxation*, 113 S. Ct. 2510 (1993), has no application here — and, even if it did, it plainly would necessarily be overridden by the takings and due process constraints outlined above. The doctrine of equivalents is a judicially developed doctrine. Altering it prospectively would present none of the jurisprudential tensions that arise when a prospective-only ruling amounts to a denial that a text — either the Constitution itself, as in *Harper*, or a federal statute, see *Plaut v. Spendthrift Farm, Inc.*, 115 S. Ct. 1447, 1451 (1995) — has had the same meaning since its enactment. There are no such tensions when this Court is engaged in elaborating judge-made law under a statutory scheme that has always been understood as leaving this Court with authority to develop supplemental rules of law, subject to congressional override. Cf. *Miles v. Apex Marine Corp.*, 498 U.S. 19, 33-36 (1990) (admiralty law); *Textile Workers v. Lincoln Mills of Alabama*, 353 U.S. 448, 451 (1957) (§ 301(a) of the Taft-

Hartley Act, 29 U.S.C. § 185(a)); *Standard Oil v. United States*, 221 U.S. 1, 69-70 (1911) (§ 1 of the Sherman Act, 15 U.S.C. § 1). Therefore, if there were an appropriate retroactivity axiom in this case, it would be the rule that positive-law enactments like statutes are presumed to have only prospective effect. *E.g.*, *Landgraf v. USI Film Prods.*, 114 S. Ct. 1483, 1497 (1994) (presumption against retroactivity is rooted in “[e]lementary considerations of fairness” and policy that “settled expectations should not be lightly disrupted”).

CONCLUSION

The judgment of the Court of Appeals should be affirmed; alternatively, any substantive restriction in the protection of patents by the doctrine of equivalents should be made purely prospective and applicable only to patent applications filed after the date of decision in this case, or at most to patents issued after that date.

Respectfully submitted.

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